Appl. No. 09/100,671
Reply to Office Action of August 11, 2004

Attorney Docket No. 35207.13
Customer No. 27683

REMARKS

Claims 70-92 are present in the application. In view of the remarks that follow, reconsideration is respectfully requested.

Information Disclosure Statement

As a courtesy, the Examiner is hereby notified that, concurrently with the filing of this Response, Applicants are also filing an Information Disclosure Statement. The Information Disclosure Statement makes of record Herz U.S. Patent No. 5,754,938, which was used by a prior Examiner to reject claims in this application, but which has never actually been formally cited and made of record in this application. In addition, the Information Disclosure Statement cites documents that have been cited in various related applications, including applications listed on page 1 of the present specification. In theory, the Information Disclosure Statement should reach the desk of the Examiner simultaneously with this Response. However, in the event it does not, this paragraph will serve to notify the Examiner that the Information Disclosure Statement has been filed.

35 USC §112, Second Paragraph

The Office Action rejects Claims 70-86 as indefinite under the second paragraph of 35 USC §112. The rejection is based on language in independent Claim 70. Claims 71-86 depend from Claim 70 and inherit the ground of rejection applied to Claim 70. This ground of rejection is respectfully traversed, for the following reasons.

The rejection notes that Claim 70 recites a "payment key", and then asserts that the present application does not disclose a payment key. Apparently, the Examiner has not been able to find the exact phrase "payment key" in the specification, and has therefore assumed that the term "payment key" must necessarily be indefinite. However, this is not a proper basis for an indefiniteness rejection. For example, as discussed in MPEP §2173.05(e):

A CLAIM TERM WHICH HAS NO ANTECEDENT BASIS IN
THE DISCLOSURE IS NOT NECESSARILY INDEFINITE
The mere fact that a term or phrase used in the claim has no
antecedent basis in the specification disclosure does not mean,
necessarily, that the term or phrase is indefinite. There is no
requirement that the words in the claim must match those used in
the specification disclosure. Applicants are given a great deal of
latitude in how they choose to define their invention so long as the
terms and phrases used define the invention with a reasonable
degree of clarity and precision.

Moreover, in this particular situation, Applicants respectfully submit that, although the
disclosure may not include the exact term "payment key", it does in fact provide a proper
antecedent basis for the terminology and limitations used in Claim 70, including "payment key".
First, the Examiner is reminded that page 1 of the specification states that the present application
is part of a group of related applications, and then incorporates into the present application by
reference the disclosures of all of the other applications in the group. One of these applications is
U.S. Provisional Application No. 60/050,411 filed June 20, 1997. The present application not
only incorporates this provisional by reference, but also claims the priority of this provisional
application under 35 USC §119. The '411 provisional application discusses a "system of private
keys" (page 1), "key technology" (page 2), "third party keys" and "unique keys" (page 3), and
"How Third Party Keys help with paying for a product" (page 4). Page 1 explains that the
"system of private keys is used to protect the identity of a buyer from the supplier of a good or
service", in a manner so that "Payment is passed on to the supplier without the supplier knowing
the identity of the buyer". It thus appears that, before making the rejection for indefiniteness, the
Examiner did not review the disclosures of all of the various applications which have been

incorporated by reference into the disclosure of the present application, including the discussion in these applications of "keys" that can be used to effect "payment".

But even if the material incorporated by reference is ignored, it is respectfully submitted that the specification and drawings of the present application, considered alone, provide clear support for the claimed subject matter. To demonstrate this, Applicants will now provide a brief explanation of one way in which certain language from Claim 70 can be read onto the exemplary embodiment which is disclosed in the specification and drawings of the present application. But it is to be understood that this explanation is provided solely by way of example, and is not to be construed as restricting in any way the intended broad scope of the language of Claim 70.

In more detail, Figure 11 of the present application is a block diagram showing a payment detail 1100, which includes a pseudo identity 1120, and also financial information such as pseudo payment types 1150. As to the pseudo payment types 1150, the specification explains in the first sentence on page 14 that each pseudo payment type 1150 includes a pseudo expiration date and a pseudo number. Figure 12 is a screen displayed during a user registration process, and shows that the pseudo number can be a pseudo credit card account number. As noted above, the payment detail 1100 of Figure 11 also includes a pseudo identity 1120, which is associated with the financial information that is in the pseudo payment types 1120, such as the pseudo credit account number and pseudo expiration date. Figure 13 is a screen that can be displayed on request. The middle right portion of Figure 13 shows that the pseudo identity 1120 can include a pseudo name "FREDSTONE0123234", and the top portion of Figure 13 shows that this pseudo name "FREDSTONE0123234" is what the specification refers to as the "Buyer ID". Lines 16-21 on page 12 refer to the Buyer ID as a "key". The specification also explains, beginning at line 7 on page 15, that in order to effect payment for a purchase, a seller can be given the Buyer ID or "key", which the seller then forwards in order to obtain payment. Thus, since the Buyer ID is a "key" that can be used to effect payment, it should be readily evident that it can be properly referred to as a "payment key". As discussed on pages 15-16, the seller forwards the Buyer ID or "key" to the privacy server 100 (Figure 1). The privacy server uses the Buyer ID to access the

corresponding payment detail 1100, and the associated financial information in it, including the pseudo payment types 1150. The privacy server 100 then returns one or more of the pseudo payment types 1150 to the seller. Then, as discussed at lines 9-10 on page 16, the seller takes one of the pseudo payment types and sends it to the financial institution 142 (Figure 1). Persons skilled in the art will readily recognize from this discussion that, in order to do this, the pseudo payment type 1150 necessarily includes either an express or implicit identification of the financial institution 142, so that the seller can contact the correct financial institution. As a practical matter, the identification of the correct financial institution can be effectively embodied in the pseudo credit account number. For example, when using a conventional credit card, the card owner merely gives the seller the card number, and does not need to give the seller the name of the particular financial institution that issued the card, because the identification of the financial institution is effectively embedded in or otherwise associated with the card number. The card number itself is thus sufficient to identify not only the proper account, but also the proper financial institution, which then transfers payment to the seller.

It is believed that, based on the foregoing discussion, the Examiner will now readily understand one way in which the language of Claim 70 can be read onto the disclosed embodiment. Applicants again emphasize that the foregoing explanation has been provided solely by way of example, and is not intended to limit in any way the broad scope of the language in Claim 70. In light of the foregoing explanation, it is respectfully submitted that all of the language in Claim 70 is in fact definite, and thus in compliance with the second paragraph of §112, and notice to that effect is respectfully requested.

35 USC §112, First Paragraph

The Office Action rejects Claims 70-92 as indefinite under the first paragraph of 35 USC §112, asserting that these claims recite subject matter "which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention". This

ground of rejection is respectfully traversed. In particular, it is respectfully submitted that all of the claimed subject matter is properly disclosed in and supported by the specification and drawings of the present application (even without taking into account the material that has been incorporated into the disclosure by reference). In the foregoing discussion of the second paragraph of §112, Applicants have provided a detailed technical explanation of where certain claimed subject matter is clearly disclosed in the present application. That explanation is also believed to resolve the rejection raised under the first paragraph of §112. Applicants are not duplicating that same technical explanation here, because it would be completely redundant to what has already been explained above. With respect to the first paragraph of §112, only one point from the Office Action is believed to need a brief further comment.

In particular, the Office Action asserts near the bottom of page 3 that it "is also not clear whether the identifier for the pseudo credit account is the pseudo number itself, since the specification does not indicate a different number for the pseudo account beside the pseudo account itself". As best understood, this assertion is raising an issue of indefiniteness rather than a question of lack of disclosure, and thus should have been raised under the second paragraph of §112, rather than the first paragraph of §112. If the Examiner believes that there is any issue here under the first paragraph of §112, then the rejection is unclear and should be reissued with clarification. On the other hand, assuming that it is in fact an indefiniteness concern under the second paragraph of §112, the Examiner is respectfully reminded that, as discussed in MPEP 2173.04, "Breadth is Not Indefiniteness", and "The fact that a claim [term] is broad does not automatically mean that it is indefinite". Here, Applicants have intentionally selected the term "identifier for a pseudo credit account" because it is a broad term that encompasses a pseudo account number (as clearly evident from dependent Claim 77), as well as other possible ways of identifying the pseudo credit account. Applicants respectfully submit that the phrase "identifier for a pseudo account number" is entirely definite and proper.

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In view of the foregoing discussion, it is respectfully submitted that all of the pending claims are in full compliance with the first paragraph of §112, and notice to that effect is respectfully requested.

Effective Dates

The present application was filed on June 19, 1998, and claims the priority of various earlier provisional and non-provisional applications, including those listed on page 1 of the specification. Pursuant to MPEP §706.02(V)(B) and (D), the present application has an effective filing date that can be as early as January 17, 1996 (depending on the subject matter of the claim in question). The Office Action sets forth some rejections under 35 USC §§102 and 103, which are discussed later. At this point, it is noted that these §§102 and 103 rejections are each based on one or more of (1) Gabber U.S. Patent No. 5,961,593, (2) Boies U.S. Patent No. 6,006,200, and (3) official notice of a particular point. However, Gabber and Boies each have an effective date which is _after_ the earliest possible effective filing date of the present application. A proper §102 or §103 rejection based on either Gabber and/or Boies would therefore need to first establish that Gabber and/or Boies is in fact prior art with respect to each and every one of the claims being rejected, and thus would need to include an explanation of why the Examiner believes that the present application is not entitled to some or all of its priority dates as to the subject matter of each rejected claim. In the outstanding Office Action, each of the §102 and §103 rejections fails to do this. In other words, the Office Action fails to establish that either Gabber or Boies is prior art with respect to any of the rejected claims,

Similarly, with respect to official notice, the Office Action simply makes a conclusory assertion on page 5 that it is (currently) well known in the art of e-commerce to set rules to define the use of accounts. However, the issue is not whether this point is currently well known in the art, but whether this point was well-known on or before the effective filing date of the present application. The Office Action does not assert that this point was known in the art as of the effective filing date of the present application, much less provide a plausible rationale as to why

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it should be considered to be known as of that date. Accordingly, Applicants respectfully traverse the indication of official notice on the ground that the point in question has not been properly officially noticed. Pursuant to MPEP §2144.03(C), Applicants respectfully request that the Examiner cite a prior art reference which provides documentary evidence that is adequate to support this point.

For the reasons discussed above, it is respectfully submitted that the §102 and §103 rejections are each based entirely on material that has not been established to be prior art, because the Office Action has failed to demonstrate that Gabber, Boies or the official notice predates the effective filing date of the present application as to each of the rejected claims. Applicants are thus not required to address any of these §102 and §103 rejections in this Response to the Office Action. Nevertheless, in an attempt to expedite examination of the present application, the remarks which follow will offer some comments regarding the merits. However, these comments should not be interpreted as a waiver of Applicants' objection to the fact that the Office Action is incomplete. If the Examiner intends to maintain these rejections, the Examiner should issue a new and non-final Office Action which cures the defects in each of the current §102 and §103 rejections.

Independent Claims 70 and 87

Independent Claims 70 and 87 each stand rejected under 35 USC §102 as anticipated by Gabber U.S. Patent No. 5,961,593. The Office Action offers the same rationale for the rejection of each of Claim 70 and Claim 87. This ground of rejection is respectfully traversed, for the following reasons. The PTO specifies in MPEP §2131 that, in order for a reference to anticipate a claim, the reference must teach each and every element recited in the claim. Moreover, as explained in MPEP §2121.01, the "disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter" (emphasis added). It is respectfully submitted that Gabber does not provide an enabling disclosure of all of the subject matter recited in Claim 70 or Claim 87. Claim 70 includes a recitation of:

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using the payment key to facilitate through the network a purchase

by the first user of something from a second user, including using

the financial information through the network to facilitate payment

for the purchase to the second user on behalf of the first user, . . .

the using of the financial information including: providing the

pseudo credit account identifier . . . to the second

user, . . .communicating the pseudo credit account identifier . . . to

the financial institution; and transmitting payment from the

financial institution to the second user on behalf of the first user

under the pseudo credit account identifier . . .

Claim 87 includes a recitation of:

establishing by the financial institution for the first entity a pseudo

credit account, an identifier for the pseudo credit account,

. . .receiving of the pseudo credit account identifier by the

financial institution from a second entity through an electronic

network in association with a purchase by the first entity of

something from the second entity, . . . transmitting of payment on

behalf of the first entity from the financial institution to the second

entity under the pseudo credit account identifier . . .

Gabber asserts at the bottom of column 6 that the disclosed embodiment can generate secure

substitute identifiers, including an alias credit card number. In addition, Gabber states at lines

45-49 of column 12 that "central proxy system 110a includes functionality necessary to support

electronic payment, [and] the users employ electronic payment information to engage in

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anonymous commerce with the server sites". However, these are vague and conclusory

statements, and Gabber makes other statements that are inconsistent with these statements. For

example, Gabber states at lines 57- of column 12 that:

> an ever increasing number of sites require a valid credit card
>
> number as part of establishing an account, so that such sites may
>
> charge the user for their services . . . . While the above-described
>
> proxy system provides substitute identifiers to free users from
>
> remembering these items and by providing a guard on
>
> (involuntary) data flowing to the web-site, it may not provide
>
> complete anonymity to a user who has provided a credit card
>
> number to a site. (Emphasis added).

At the bottom of column 12, Gabber suggests that one solution to this problem is that

Gabber's proxy server could provide its own valid credit card number to sellers on behalf of

buyers, and then collect money from the buyers, so that the sellers do not know the actual identity

of the buyers. But this solution involves use of an actual credit card number, rather than a

pseudo card number. Beginning in line 5 of column 13, Gabber goes on to indicate that an

alternative is that the proxy server could generate an alias credit card number and provide it to

sellers, who would accept it because they know it originates from the proxy server. But if the

sellers know that the alias credit card number originates from the proxy server, then as a practical

matter there is no significant difference from the approach of using an actual credit card number

of the proxy server, because in each case the seller is fully aware of the identity of the proxy

server.

Thus, Gabber has jumbled and inconsistent teachings about whether it is possible to

provide a pseudo credit account number. Moreover, the vague and conclusory statements in

Gabber about "alias" credit card numbers do not amount to an enabling disclosure of how to

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actually implement this concept. For example, Gabber states at lines 34-40 of column 3 that

Gabber's disclosure teaches suitable ways of generating substitute identifiers, such as an "alias"

credit card number. However, these teachings all involve the use of an algorithm that calculates

as the substitute identifier a somewhat random number based on "seed" information provided by

the user. While this may be acceptable for the alias e-mail addresses discussed in Gabber, it will

not work for an alias credit card number. In particular, Gabber's proxy server will be aware of

the somewhat random number generated in this manner to serve as an alias credit card number,

but there is no financial institution that is aware of this number or that is prepared to make any

payment against the number. Consequently, if this number were to be provided to a seller, and if

the seller were then to attempt to actually obtain payment by submitting the number through the

normal credit-card processing channel (i.e. the channel routinely used for cards such as VISA,

MasterCard, American Express, Discover, and so forth), Gabber's "alias" card number would be

rejected or "bounce", because there is no financial institution that is aware of the number or

prepared to make payment against it. Further, since the number is somewhat randomly

generated, there is some statistical possibility that it could accidentally and coincidentally be

identical to the real credit card number of some person not even involved with the Gabber

scheme. In that case, if the seller submitted Gabber's alias number through the normal credit-

card processing channel, the seller would be paid, but by someone other than the buyer. This

would involve issues of potentially illegal conduct such as "identity theft", and would be an even

bigger problem than if Gabber's alias card number simply "bounced". The bottom line is that

Gabber never even mentions involving a financial institution with any alias credit card number,

and thus does not provide an enabling disclosure of how any such scheme could actually be

implemented. And even the involvement of a financial institution would not overcome the

various problems that would result from implementing the teaching in Gabber that the alias

numbers would be generated in a somewhat random manner based on a "seed". This may be

why, beginning at line 66 of column 12, Gabber ends up suggesting that a workable solution

might need to involve use of an actual valid credit card number of the proxy server (rather than

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pseudo credit account numbers issued by a financial institution for respective different users).

Accordingly, since Gabber does not provide an enabling disclosure of each and every element recited in Claim 70 and in Claim 87, Gabber does not anticipate Claims 70 and 87 under 35 USC §102. Moreover, for reasons discussed above, it is respectfully submitted that the §102 rejections of Claim 70 and Claim 87 are defective, because they fail to properly establish that Gabber is prior art as to Claims 70 and 87. Claims 70 and 87 are therefore believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claims

Claims 71-86 and Claims 88-92 respectively depend from Claim 70 and Claim 87, and are also believed to be distinct from the art of record, for example for the same reasons discussed above with respect to Claims 70 and 87. Moreover, for reasons discussed above, it is respectfully submitted that all of the §102 and §103 rejections of these claims are defective, because they fail to properly establish that they are based on prior art.
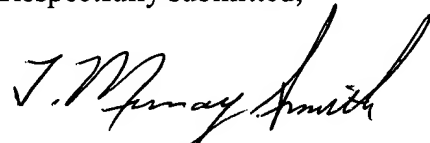
Conclusion

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

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Although Applicants believe that no fees are due in association with the filing of this Response, the Commissioner is hereby authorized to charge any additional fee required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone LLP.

Respectfully submitted,

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Date: September 10, 2004

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